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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

#9
K DAVIS
12-4-03

Appellant:

David L. PATTON

Group Art Unit: 2622

Serial No.: 09/359,152

Examiner: M. Mitchell

Filed: 22 July 1999

Attorney Docket No.: 79687RLO
(Rossi Docket No.: KODA:301)

For: AUTHORIZING THE PRINTING OF DIGITAL IMAGES

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APPEAL BRIEF

WITH FEE AND PETITION FOR TIME EXTENSION

Sir:

Appellant appeals claims 1-5 as rejected in the February 26, 2003 Final Rejection. Appellant has filed a Notice of Appeal on August 25, 2003. Original and two copies of the Appeal Brief are enclosed. This reply requires a petition for a one-month extension.

Appellant requests a one-month extension, from October 25, 2003 to November 25, 2003, for replying to the outstanding Office Action. The one-month extension fee is \$110. The fee for filing this Appeal is \$330. The Commissioner is authorized to charge \$440 (or any additional fees required to maintain the pendency of this application) to Deposit Account No. 18-2056.

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01 FC:1402 330.00 DA
02 FC:1251 110.00 DA

Real Party in Interest - Rule 192(c)(1)

The real party in interest is EASTMAN KODAK COMPANY.

Related Appeals and Interferences - Rule 192(c)(2)

No related appeal or interference that would directly affect or have affect or bearing on the Board's decision in this appeal is believed to exist. Appellant will identify any such appeal or interference if it exists.

Status of Claims - Rule 192(c)(3)

Claims 6-10 have been canceled and claims 1-5 stand finally rejected under 35 U.S.C. § 102(e) as anticipated by Enomoto (USP 5,974,401). No claim has been allowed.

Status of Amendment(s) - Rule 192(c)(4)

No Amendment has been filed after the Final rejection. Accordingly, appellant appeals claims 1-5, as finally rejected. A copy of the claims involved in this appeal is appended hereto.

Summary of the Invention - Rule 192(c)(5)

The present invention relates to a method of remotely ordering custom designed postage stamps, where the consumer or requestor supplies the image that will appear on the stamp. The image can be any desired image (40, 210). The requestor then transmits the selected image, along with authorization information to a receiving agency, such as a post office (80) or other entity authorized to print postage stamps (140). See page 5, lines 4-11, and page 6, lines 8-12. Upon receipt, the receiving agency then displays the selected image on a monitor to determine whether the subject matter of the image is appropriate for use as a postage stamp. See page 2, lines 13-14, 21-24, page 7, lines 29-30. If both the image and the authorization information is approved, postage stamps displaying the selected image are printed. See page 7, line 29 - page 8 line 3.

Issues On Appeal - Rule 192(c)(6)

Whether Enomoto would have anticipated claims 1-5 obvious within the meaning of § 102.

Grouping of Claims - Rule 192(c)(7)

The claims on appeal contain a single independent claim, claim 1. For purposes of this appeal, depending claims 2-5 rise or fall with claim 1. Accordingly, this appeal contains only a single group of argument.

APPELLANT'S ARGUMENT - Rule 192(c)(8)

ENOMOTO WOULD NOT HAVE ANTICIPATED CLAIM 1 BECAUSE IT WOULD NOT HAVE DISCLOSED EXAMINING THE DISPLAYED DIGITAL IMAGE TO DETERMINE WHETHER ITS CONTENTS ARE ACCEPTABLE FOR MAKING POSTAGE STAMP IMAGES

Claim 1 calls for electronically transmitting a digital image file, which includes a digital image for making postage stamp images on a receiver. The receiving agency examines the digital image to determine whether the image is suitable (not offensive in nature or not) for postage stamps. See page 2, lines 14-15, 21-24, page 7, lines 29-30.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Enomoto would not have anticipated claim 1 because it does not disclose, explicitly or inherently, step c) of claim 1. In this regard the meaning of the language “*examining the displayed digital image to determine whether its contents are acceptable for making postage stamp images*” recited in claim 1 should be interpreted to mean evaluating whether the content of the stamp image is “*offensive in nature.*” Here, we are exclusively dealing with printing of “postage stamps” that is heavily regulated. The USPS is empowered to provide and sell postage stamps, stamped cards, and envelopes and to provide other evidence of postage and fees as necessary. In this regard, the preclusion of offensive images as potential postage stamps is not simply a tacit acknowledgement of and concession to the public mores of decency, but is also required in order to comply with

current federal statutes. Consequently, any authorization to a private entity to create or sell postage stamps would have to come from the USPS and be subject to USPS terms and limitations. Currently any obscene, lewd, lascivious, indecent, filthy or vile article, matter, thing, device or substance is declared to be nonmailable matter and as such is prohibited from being conveyed via the U.S. Postal Service. 18 USC § 1461 (2001). Clearly, an image from which a postage stamp is to be made must comport with federal statutes and regulations regarding content; consequently necessitating an examination and evaluation to ensure conformity. In this vein, the meaning language “*examining the displayed digital image to determine whether its contents are acceptable for making postage stamp images*” should be construed in connection with weeding out offensive images, not in terms of enhancing or correcting image quality.

The manual image quality adjustment called for in Enomoto does not correspond to evaluating whether the image content is offensive or not. Rather, it merely calls for adjusting or enhancing the setting of the image, such as color balance, appearance:

If the manual correction by operator is selected, the work station 13 selects a manual print processing within business hours, and does not carry out auto-printing. In this case, the operator carries out *the image processing* to provide the best density and color balance, then makes the prints 33, 35, or 36 by using the printer 15, 16, or 17. [Column 7, lines 32-38].

Indeed, the examiner acknowledges that the “operator is able to observe the image data and make *corrections* to it to make the print acceptable for printing.” (Emphasis added). There is a critical distinction between *correcting* an image for printing and *examining suitability for postage stamps*. Nowhere does Enomoto disclose performing a subjective evaluation of the image content or subject matter for suitability for use as a postage stamp so as to avoid the use of offensive images. Making *corrections* to make the print *acceptable* for printing does not correspond to *examining the displayed digital image to determine whether its contents are acceptable for making postage stamp images*.

The examiner realizing Enomoto’s shortcoming, argues that “In viewing the simulated

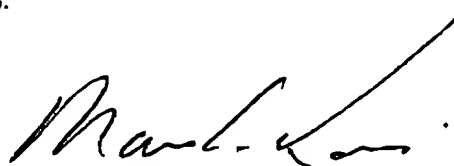
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print, the operator can also report/question any unsuitable or offensive images that go against the moral and ethical policies of the receiving agency." However, the examiner does not provide any support for this conclusion. It examiner's "could have used" conjecture is improper in determining patentability.

Conclusion

As Enomoto would not have disclosed the method step of *examining the displayed digital image to determine whether its contents are acceptable for making postage stamp images* as recited in claim 1, Enomoto would not have anticipated claim 1. Appellant therefore respectfully urges the Board to reverse the rejection of these claims.



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print, the operator can also report/question any unsuitable or offensive images that go against the moral and ethical policies of the receiving agency.” However, the examiner does not provide any support for this conclusion. It examiner’s “could have used” conjecture is improper in determining patentability.

Conclusion

As Enomoto would not have disclosed the method step of *examining the displayed digital image to determine whether its contents are acceptable for making postage stamp images* as recited in claim 1, Enomoto would not have anticipated claim 1. Appellant therefore respectfully urges the Board to reverse the rejection of these claims.

CLAIMS ON APPEAL - Rule 192(c)(9)

1. A method of authorizing the making of postage stamp images on a receiver by a receiving agency comprising the steps of:
 - (a) electronically transmitting a digital image file over a channel to the receiving agency;
 - (b) the digital image file includes at least one digital image and authorization information for making postage stamp images on a receiver; and
 - (c) receiving the digital image file at the receiving agency, displaying at least one received digital image and examining the displayed digital image to determine whether its contents are acceptable for making postage stamp images and examining the authorization information and printing at a designated location that accepts digital images on a receiver corresponding to the transmitted digital image when the authorization information is approved.
2. The method of claim 1 wherein the transmitted digital image is converted by a display to a visual image which is viewed to determine if it is acceptable.
3. The method of claim 1 wherein the authorization information is examined by logic and control means to determine that whether or not the authorization information is approved.
4. The method of claim 1 wherein the images are printed by a thermal printer, electrophotographic printer, ink jet or photographic printer.
5. The method of claim 1 wherein the digital image and the authorization information is transmitted over the Internet.